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REMARKS

The Examiner has rejected Claims 1-41 under 35 U.S.C. 101 as being directed to non-statutory subject matter. Applicant respectfully asserts that such rejections are avoided in view of the clarifications made to each of the independent claims.

The Examiner has rejected Claims 1-41 under 35 U.S.C. 103(a) as being unpatentable over Kephart (U.S. Patent No. 6,732,149) in view of Nachenberg (U.S. Patent No. 6,021,510). Applicant respectfully disagrees with such rejection, especially in view of the amendments made hereinabove to each of the independent claims. Specifically, applicant has amended independent Claims 1, 10, 35, and 38 to include the subject matter of dependent Claim 7 et al. In addition, applicant has amended independent Claims 20 and 27 to include the subject matter of dependent Claim 22 et al.

With respect to independent Claims 20 and 27, the Examiner has relied on the following excerpt from Nachenberg to make a prior art showing of applicant's claimed "parsing module parsing the field values from each field in the header and the message content from the body" (see this or similar, but not identical language in Claims 20 and 27).

"A parser is first needed, because the parser can distinguish between critical portions of a file, e.g., distinguish between executable code and data. After the parser has determined what are the critical portions of the file for purposes of antivirus protection, a hasher can be built to create the hash value based upon the critical portions of the file." (Col. 2, lines 56-63)

Applicant respectfully asserts that the above excerpt fails to teach parsing "field values from each field in the header and the message content from the body" (Claims 20 and 27) as claimed by applicant, since such excerpt only discloses a "parser...distinguish[ing] between critical portions of a file." Clearly, critical portions, as in Nachenberg, to do not meet applicant's specifically claimed field values and message content.

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With respect to independent Claims 1 and 10, the Examiner has relied on the following excerpts from Kephart to make a prior art showing of applicant's claimed "checksum module storing the checksum in an information file associated with the incoming message in a transient message store" (see this or similar, but not identical language in the foregoing claims).

"...adding the signature to a signature database..." (Col. 5, lines 52-53)

"The signature information preferably includes a signature from the at least one specific electronic message. The storing step can include the step of storing the signature in at least one signature database." (Col. 6, lines 23-26)

Applicant respectfully asserts that simply storing a signature, as in Kephart, does not rise to the level of specificity of applicant's claimed checksum. In addition, Kephart teaches a signature that is merely stored in a signature database, whereas applicant claims "storing the checksum in an information file associated with the incoming message in a transient message store." Thus, only applicant teaches and claims a "checksum [that is stored] in an information file associated with the incoming message in a transient message store," as claimed.

Also with respect to independent Claims 1 and 10, the Examiner has relied on Col. 6, line 57-Col. 7, line 24 in Kephart to make a prior art showing of applicant's claimed "recording the checksum corresponding to each infected message content and an infection indicator." However, after carefully reading such excerpt, it is clear that the only "stored checksum" in Kephart relates to "comparing a computed checksum [of a region of the specific electronic message] with a stored checksum" (see specifically Col. 7, lines 17-22). Therefore, the stored checksum in Kephart is not disclosed to "[correspond] to each infected message content," as claimed by applicant, but is instead only compared against a computed checksum that corresponds to the electronic message.

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With respect to independent Claims 20 and 27, the Examiner has relied on item 616 of Figure 6 and item 418 of Figure 4 to make a prior art showing of applicant's claimed "update module updating the message digest corresponding to each infected message content with an infection indicator" (see this or similar, but not identical language in each of the forgoing claims). Applicant respectfully asserts that such items relied on by the Examiner merely relate to updating local signature databases and a master signature database "with information about the new instance of the undesirable message" (Col. 16, lines 39-40), whereas applicant specifically claims updating a "message digest corresponding to each infected message content with an infection indicator" (emphasis added). Clearly, a signature database, as in Kephart, does not meet applicant's claimed "message digest corresponding to each infected message content."

With respect to independent Claims 35 and 28, the Examiner has failed to even consider applicant's claimed "checksum module calculating and storing a checksum over the message packet content stored in the body of the incoming message packet" or "an antivirus scanner scanning an incoming message if the at least one of the checksum and the digest have not been previously stored with an infection indicator indicating a presence of at least one of a computer virus and malware" (see this or similar, but not identical language in each of the foregoing claims-emphasis added).

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir.1991).

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Applicant respectfully asserts that at least the third element of the *prima facie* case of obviousness has not been met, since the prior art references, when combined, fail to teach or suggest all of the claim limitations, as noted above. Nevertheless, despite such paramount deficiencies and in the spirit of expediting the prosecution of the present application, applicant has substantially incorporated the subject matter of dependent Claim 7 et al. into independent claims 1, 10, 35, and 38. Further, applicant has substantially incorporated the subject matter of dependent Claim 22 et al. into independent Claims 20 and 27.

With respect to the subject matter of dependent Claim 7 et al. (now incorporated into the independent claims noted above), the Examiner has failed to specifically address applicant's claimed technique "wherein the checksum is calculated as a running checksum on a line-by-line basis as the incoming message is received" (see this or similar, but not identical language in each of the foregoing claims). Applicant notes that the excerpts in Kephart relied on by the Examiner simply teach deleting or altering the appearance of a message (Col. 16, lines 22-23), updating a master signature database with information about a new instance of an undesirable message (item 616 of Figure 6) and comparing a computed checksum with a stored checksum (Col. 7, lines 20-22). Thus, such excerpts clearly fail to meet applicant's specific claim language, namely "[calculating] the checksum...as a running checksum on a line-by-line basis as the incoming message is received."

With respect to the subject matter of Claim 22 et al. (now incorporated into the independent claims noted above), the Examiner has relied on Col. 5, lines 49-53, Figure 3 and Col. 6, lines 62-64 in Kephart to make a prior art showing of applicant's claimed "maintaining a set of digests, each comprising the message digest and the infection indicator corresponding to each infected message content" (see this or similar, but not identical language in each of the foregoing claims). Applicant respectfully asserts that such excerpts merely disclose labeling a message as undesirable, and not "a set of digests, each comprising the message digest and the infection indicator corresponding to each infected message content," as claimed by applicant (emphasis added).

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A notice of allowance or a specific prior art showing of all of applicant's claim limitations, in combination with the remaining claim elements, is respectfully requested.

The Examiner's rejections are also deficient with respect to the dependent claims, since such rejections also do not meet each and every element of the *prima facie* case. For example, with respect to dependent Claim 3 et al., the Examiner has relied on Col. 5, lines 49-57, Col. 6, lines 10-12, Col. 7, lines 16-24 in Kephart and Figure 1 in Nachenberg to make a prior art showing of applicant's claimed "table of entries, each comprising the checksum and the infection indicator corresponding to each infected message content."

Applicant respectfully asserts that the excerpts in Kephart do not teach any sort of "table of entries." In addition, Kephart only teaches "labeling the message as undesirable" (emphasis added), but not a table of entries comprising in part an infection indicator, in the context claimed by applicant. Furthermore, Figure 1 in Nachenberg does not show a table, but rather merely depicts hash values in memory (RAM and disk). Thus, clearly applicant's claim language has not been met by the combination of references.

The Examiner has also rejected dependent Claim 5 et al. under Kephart's teachings of deleting or altering the appearance of a message (Col. 16, lines 22-23), updating a master signature database with information about a new instance of an undesirable message (item 616 of Figure 6), and comparing a computed checksum with a stored checksum (Col. 7, lines 20-22). Again, such excerpts do not meet applicant's specifically claimed "replacing entries in the table using a least-recently-used replacement algorithm."

Since at least the third element of the *prima facie* case of obviousness has not been met, a notice of allowance or a specific prior art showing of all of the claim limitations, in the context of the remaining elements, is respectfully requested.

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Still yet, applicant brings to the Examiner's attention the subject matter of new Claims 42-44 below, which are added for full consideration:

"wherein the incoming message is not scanned by the antivirus scanner if the checksum of the incoming message matches the checksum of one such entry with one such infection identifier" (see Claim 42);

"wherein the field values include a subject value" (see Claim 43); and

"wherein the message content only includes scripted portions in an Hypertext Markup Language (HTML) incoming message" (see Claim 44).

Thus, all of the independent claims are deemed allowable. Moreover, the remaining dependent claims are further deemed allowable, in view of their dependence on such independent claims.

In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 505-5100. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 50-1351 (Order No. NAI1P392/01.088.01).

Respectfully submitted,
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